

REMARKS/ARGUMENTS

The Office Action rejected Claims 33-39 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,394,355 to Schlieffers et al. In support of the rejection of Claims 33-39, the Office Action reasons that, although the reference is silent as to a self-checkout station, self-checkout stations are well known and conventional in the art, and it would have been obvious to one of ordinary skill in the art to combine a known self-checkout station with the Schlieffers et al. reference to produce the claimed invention. This rejection is improper and should be withdrawn.

A claimed invention may be found to have been obvious “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains.” 35 U.S.C. § 103(a) (2000). To establish a *prima facie* case of obviousness of a claimed invention, the prior art reference or references must teach or suggest all of the claim limitations. MPEP § 2143.03. Clearly, U.S. Patent No. 6,394,355 to Schlieffers et al. fails to meet this very basic requirement. In fact, the Office Action acknowledges that the reference “is silent [as] to a self-checkout station and a customer operated payment accepting subsystem.” Office Action, Page 3 at Top. The Office Action asserts that self-checkout systems are well known to fill the gaps in the prior art. However, the level of ordinary skill in the art cannot be relied upon to provide a suggestion to combine references. MPEP § 2143.01. Further, it is never appropriate to rely on common knowledge without evidentiary support in the record. MPEP § 2144.03(A)(citing *In re Zurko*, 257 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)).


Thus, as the Office Action proffers no teaching, suggestion, or motivation to combine or modify the prior art as evidence that the claimed invention would have been obvious, the rejection must arise from impermissible hindsight reconstruction of the applicant’s invention. But the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. MPEP 2143. The Office Action states that self-checkout stations themselves are known to “reduce the amount of workers to complete a transaction.” Office Action, Page 3 at Top. However, this general statement could be used to reject as

obvious any claimed self-checkout station in combination with *any* existing retail sales system of *any* kind. Such a generalized statement of advantages apparent after review of the applicant's disclosure does not pass muster. A rigorous application of the requirement for a showing of the teaching or motivation to combine or modify prior art references to produce the claimed invention is required. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Conclusion

To establish a *prima facie* case of obviousness of a claimed invention, the prior art reference or references must teach or suggest all of the claim limitations. The prior art does not teach or suggest the invention of Claim 33. The Office Action points to no evidence of motivation to modify the Schlieffers et al. reference to produce the claimed invention. Thus the rejection of Claims 33-39 is improper. Claims 33-39 are in condition for allowance.

Respectfully submitted,



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